

Application No. 09/944,131
Amendment dated August 15, 2005
Reply to Office Action of May 13, 2005

REMARKS

Claims 1-26 are currently pending and under examination. Claims 5-6 and 19-22 are canceled and claim 23 is amended herein. Claim 23 is amended to depend from claim 1 to narrow the issues for consideration and to advance prosecution (e.g., at page 15, ¶ 33 of the instant Office action the Office has noted similarities between claims 15 and 23). Support for amended claim 23 can be found throughout the specification and claims as originally filed, for example, at page 5, lines 24-26; page 31, line 13 et seq. No new matter is added and entry of the present amendment is respectfully requested.

Rejection of Claims 1-2, 8-9, and 13-14 Under 35 U.S.C. § 103

Claims 1-2, 8-9, and 13-14 remain rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over U.S. Patent No. 6,061,697 (*Nakao*), in view of U.S. Patent No. 5,805,897 (*Glowny*). Applicant respectfully traverses the rejection.

The applicant re-submits that the *Nakao* and *Glowny* references are not properly combinable for at least reasons provided in the January 27, 2005 reply. In particular, *Nakao* and *Glowny* taken together produce a "seemingly inoperative" system. See *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001). Similarly, without reference to a clear and particular motivation to combine *Nakao* with *Glowny*, the Office has appeared to "take[] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed Cir. 1999). The applicant respectfully submits that the accompanying expert declaration by Robert Tischer (who is the inventor and was an expert in the fields of learning theory, linguistics and computer science at the time of the invention) clearly illustrates the differences between the claimed invention and the cited art references, the lack of motivation to combine these references and the inoperability of a combined *Nakao/Glowny* system.

As also noted in the attached expert declaration by Robert Tischer, the asserted combination of *Glowny* with *Nakao* fails to teach at least the following elements of claim 1: (1) "multiple fragment editor executables that function cooperatively as one implemented document

Application No. 09/944,131
Amendment dated August 15, 2005
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type declaration (DTD)”; (2) operation “in a peer-to-peer environment without need for a central server”; and (3) “allowing multiple authors to edit the distributed document contemporaneously while allowing each of the multiple authors to view edits made by others of the multiple authors contemporaneously.”

According to Mr. Tischer, it appears that the Office has misinterpreted the meaning of the term “contemporaneously” as it is used in the claims and supported by the specification.¹ The Office construes this term to mean “happening within a reasonable time interval of one another.” See May 13, 2005 Office action, page 17. The basis for the Office’s interpretation appears to be that “it is impossible to verify that two events occur at exactly the same time.” *Id.* However, as declared by Mr. Tischer, in *Nakao* there is always a *delay* between the edit event and propagation to all of the DTD element’s content. Further, the content changes and model variation changes of *Nakao* can only be observed at another author’s site upon request (preset or manual), due to the nature of the client-server model. In contrast, as further declared by Mr. Tischer, the claimed system utilizes the cooperative functioning of the multiple fragment executables as one implemented DTD to *push* edit events, either actually or virtually, *as they occur*, without a “request” or specific “time interval.” As stated by Mr. Tischer, in the claimed invention the executables all function complementarily with regard to the other author’s executables, thus each author may alter content or context at will to the extent of his executable’s functionality, without conflicting with other author’s contributions. Context as well as content immediacy is not only possible in the claimed system, it is inherent as change is an event that drives synchronizing changes at other replicate sites. Accordingly, it should be clear that *Nakao* fails to teach or suggest at least the three limitations recited above.

The Office credits *Glowny* for teaching “information about the use of peer-to-peer networks that would have rendered usage of such technology obvious to one of skill in the art at the time of the invention.” *Id.* However, as evidenced in the accompanying declaration of Mr.

¹ See, e.g., specification at page 6, lines 1-4; page 21, lines 23-25; page 22, lines 24-28; Figures 1-5. The applicant notes that the interpretation advanced by the Office also conflicts with its plain and ordinary meaning. For example, Merriam-Webster Online Dictionary defines “contemporaneously” as – “existing, occurring, or originating during the same time.” See <http://www.m-w.com>.

Application No. 09/944,131
Amendment dated August 15, 2005
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Tischer, one of skill in the art would not have interpreted *Glowny* as teaching the claimed peer-to-peer environment, which involves pushing context and content edit changes to document replicates. As declared by Mr. Tischer, *Glowny* appears to teach that software can respond to a request that has been copied and installed on a remote system, which installed software is comprised of a particular operation. *Glowny* also appears to teach that execution of the now remote operation can then be accomplished using a remote command execution procedure. The remote execution of operations of *Glowny* contrasts with the claimed limitation of allowing multiple authors to make changes in a single distributed document contemporaneously. Mr. Tischer further declares that *Glowny* does not teach any hierarchy of execution and its remote operations have no order associated with each other, which are requirements for placing an operation in a document context hierarchy constrained to a particular order, which, in turn, is a prerequisite for having a contemporaneously viewable document. Thus, *Glowny* also does not teach contemporaneous editing or the other limitations of the claims set out above.

As evidenced by the accompanying declaration by Mr. Tischer, the combination of *Glowny* with *Nakao* to provide a hypothetical peer-to-peer (P2P) system would result in an inoperable system. Mr. Tischer has provided hypothetical scenarios that clearly illustrate this conclusion. In sum, modifying *Nakao* to remove the server, which normally imposes a form of one-at-a-time check-out/check-in concurrency, would fail because each author would copy over each other's changes, and would be unworkable due to (1) the inordinate amount of redundant data sent across the network for each change (2) the constant interruption in the editing process, and/or (3) the need to continually merge and resolve potentially conflicting changes. No teaching of *Glowny* would resolve these problems. In contrast, the claimed invention solves these content sharing and structural change problems by dividing up the elements of the system before any author contributes so that no two authors own the same element in the document tree at the same time.

Accordingly, in view of the present arguments and the accompanying Declaration under 37 C.F.R. § 1.132, the applicant respectfully requests withdrawal of this rejection.

Application No. 09/944,131
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Rejection of Dependent Claims 3 and 4 Under 35 U.S.C. § 103

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as purportedly obvious over *Nakao*, in view of *Glowny*, and further in view of U.S. Patent No. 5,918,010 (*Appleman*). Claims 3 and 4 depend from independent claim 1. The applicant respectfully traverses.

Claims 3 and 4 depend from claim 1. As described above, the combination of *Glowny* with *Nakao* fails to teach multiple limitations of claim 1. The inclusion of *Appleman* in this combination of references fails to teach at least the deficiencies of these references versus claim 1. As such, regardless of any purported relevance of *Appleman* to the stand-alone limitations of claims 3 or 4, the addition of this reference fails to teach or suggest the overall invention claimed in these claims, each of which incorporate the limitations of claim 1. As such, the applicant respectfully requests withdrawal of this rejection.

Rejection of Dependent Claims 5 and 6 Under 35 U.S.C. § 103

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as purportedly obvious over *Nakao*, in view of *Glowny* and *Appleman*, and further in view of U.S. Patent No. 5,764,731 (*Yablon*). Claims 5-6 are canceled herein, thus rendering this rejection moot.

Rejection of Dependent Claim 7 Under 35 U.S.C. § 103

Claim 7 stands rejected under 35 U.S.C. § 103 as purportedly obvious over *Nakao*, in view of *Glowny*, and further in view of U.S. Patent No. 6,802,022 (*Olson*). The applicant respectfully traverses.

Claim 7 depends from claim 1. As described above, the combination of *Glowny* with *Nakao* fails to teach multiple limitations of claim 1. The inclusion of *Olson* in this combination of references fails to teach at least the deficiencies of these references versus claim 1. As such, regardless of any purported relevance of *Olson* to the stand-alone limitations of claim 7, the addition of this reference fails to teach or suggest the overall invention claimed in these claims, each of which incorporate the limitations of claim 1. As such, the applicant respectfully requests withdrawal of this rejection.

Application No. 09/944,131
Amendment dated August 15, 2005
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Rejection of Dependent Claims 10 and 12 Under 35 U.S.C. § 103

Claims 10 and 12 stand rejected under 35 U.S.C. § 103 as purportedly obvious over *Nakao*, in view of *Glowny*, and further in view of U.S. Patent No. 6,519,603 (*Bays*). The applicant respectfully traverses.

Claims 10 and 12 depend from claim 1. As described above, the combination of *Glowny* with *Nakao* fails to teach multiple limitations of claim 1. The inclusion of *Bays* in this combination of references fails to teach at least the deficiencies of these references versus claim 1. As such, regardless of any purported relevance of *Bays* to the stand-alone limitations of claims 10 or 12, the addition of this reference fails to teach or suggest the overall invention claimed in these claims, each of which incorporate the limitations of claim 1. As such, the applicant respectfully requests withdrawal of this rejection.

Rejection of Claims 11 and 15-26 Under 35 U.S.C. § 103

Claims 11 and 15-26 stand rejected under 35 U.S.C. § 103 as purportedly obvious over *Nakao*, in view of *Glowny*, and *Bays*, and further in view of U.S. Patent No. 5,297,279 (*Bannon*). The applicant respectfully traverses.

Claims 11, 15-18 and 23-26 depend directly or indirectly from claim 1. As described above, the combination of *Glowny* with *Nakao* fails to teach multiple limitations of claim 1. The inclusion of *Bays* and *Bannon* in this combination of references fails to teach at least these above described limitations. As such, regardless of any purported relevance of *Bays* and/or *Bannon* to the stand-alone limitations of claims 11, 15-18 and/or 23-26, the addition of these references fails to teach or suggest the overall invention claimed in these claims, each of which incorporate the limitations of claim 1.

Claims 19-22 are canceled here, thus rendering this rejection moot as it applies to these claims.

As such, the applicant respectfully requests withdrawal of this rejection.

Application No. 09/944,131
Amendment dated August 15, 2005
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CONCLUSION

If, for any reason, the Examiner determines that the pending claims are not in condition for allowance, Applicant requests that the Examiner call the undersigned attorney at 202-736-8143 in an effort to resolve any matter still outstanding *before* the issuance of another action.

Favorable reconsideration is respectfully requested.

Applicant believes that no additional fee is due. However, if any fee under 37 C.F.R. §§ 1.16 or 1.17 should be due to render this response timely or otherwise to maintain status of the application as pending, the Commissioner is requested to charge such fee to our Deposit Account no. 18-1260 referencing docket number 22339-40020.

Respectfully submitted,



David L. Devernoe
Registration No. 50,128
Attorney for Applicant

SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
Phone: 202-736-8143
Fax: 202-736-8711

Date: August 15, 2005